

Amendment and Response under 37 C.F.R. 1.116

Applicant: Ken G. Pomaranski et al.

Serial No.: 10/699,423

Filed: Oct. 31, 2003

Docket No.: 200209704-1

Title: SYSTEM AND METHOD FOR TESTING A CELL

REMARKS

The following remarks are made in response to the Final Office Action mailed July 24, 2006. Claims 1, 5-10 and 13-18 were rejected. Claims 2-4 were objected to. Claims 11 and 12 have been withdrawn from consideration. Claims 19-23 were allowed.

With this Response, claim 1 has been amended. Claim 2 has been cancelled without prejudice as to the subject matter contained therein. Claim 24 has been added. Claims 1, 3-10, and 13-24 remain pending in the application and are presented for reconsideration and allowance.

Request to Withdraw the Finality of the Office Action

Applicant respectfully notes that in the present Office Action which was made final, the Examiner introduces two new grounds of rejection that were neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement. Namely, the rejection of claims 14-18 under 35 U.S.C. §101 and the rejection of claim 9 under 35 U.S.C. §112, second paragraph, were neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement. The amendments made by Applicant in response to the previous Office Action had no bearing on, and thus did not necessitate, the rejections under 35 U.S.C. §§101 and 112, second paragraph.

Accordingly, Applicants respectfully request withdrawal of the finality of the present Office Action and the full entry and consideration of this Amendment and Response. See MPEP §§706.07(a), 706.07(c), and 706.07(d).

Claim Rejections under 35 U.S.C. §101

Claims 14-18 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Office Action alleges that the claims recite a group of actions performed by a computer, but these actions produce no tangible result; therefore, the claims are directed to non-statutory subject matter.

Applicant respectfully submits that claims 14-18 are statutory process claims that are limited to a practical application within the technological arts. See MPEP

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§§2106(IV)(B)(2)(b) and 2106(IV)(B)(2)(b)(ii). Applicants respectfully submit that, in the very least, “testing the first cell with a test module that is external to the first cell”, as recited in claim 14, produces a tangible result. Further, Applicants respectfully submit that “storing results associated with testing the first cell” as recited in claim 17 produces an additional tangible result.

Accordingly, Applicants respectfully request withdrawal of rejection of claims 14-18 under 35 U.S.C. §101.

Claim Rejections under 35 U.S.C. §112

Claim 9 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states that “[t]he use of the trademarked phrase as a claim limitation, I2C, renders the claim indefinite.”

Applicants respectfully note that a search of the Trademark Electronic Search System (Tess) performed by Applicants on August 29, 2006 on the U.S. Patent and Trademark Office website did not reveal any trademark registrations for “I2C” or even “I2C connection” as recited in claim 9. Accordingly, Applicants respectfully submit that the Office Action has not established that “I2C” is a “trademarked phrase” as alleged.

Even if I2C” is a “trademarked phrase” as alleged, Applicants respectfully note that “[t]he presence of a trademark or trade name in a claim is not, *per se*, improper.” MPEP 2173.05(u). Accordingly, Applicants respectfully request that the Examiner provide substantive reasons for rejecting claim 9 under 35 U.S.C. §112, second paragraph, rather than merely alleging that a “trademarked phrase” appears in claim 9.

Applicants also respectfully note that a search of the USPTO Patent Full-Text and Image Database performed by Applicants on August 29, 2006 on the U.S. Patent and Trademark Office website revealed 64 U.S. patents that included “I2C” in the claims.

For these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 9 under 35 U.S.C. §112, second paragraph.

Claim Rejections under 35 U.S.C. §102 and Claim Objections

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Claims 1, 5-10, and 13 are rejected under 35 U.S.C. §102(b) as being anticipated by Kauffman et al. (U.S. Patent No. 6,199,179).

Claims 2-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 1 has been amended to include all limitations of objected to claim 2, and claim 2 has been canceled. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. §102(b).

Claims 3-10 and 13 depend from claim 1. Accordingly, Applicants respectfully request withdrawal of the objections to claims 3 and 4 and the rejection of claims 5-10 and 13 under 35 U.S.C. §102(b).

Objected to claim 4 has rewritten in independent form as new claim 24 to include all of the limitations of the base claim and any intervening claims. Accordingly, Applicants respectfully request withdrawal of the objection to claim 24.

Rejoinder of Non-Elected Claims

Non-elected claims 11 and 12 depend from claim 1. Because claim 1 is in a form for allowance as noted above, Applicants respectfully request rejoinder of claims 11 and 12. See MPEP §821.04.

Allowable Subject Matter

Claims 19-23 were allowed.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1, 3-10, and 13-24 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1, 3-10, and 13-24 is respectfully requested. In addition, rejoinder of claims 11 and 12 is respectfully requested.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

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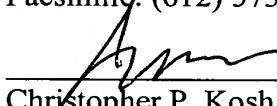
Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31st day of August, 2006.

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